

### **REMARKS/ARGUMENTS**

In the Office Action mailed February 13, 2004, claims 1-7 and 10-20 were rejected under 35 U.S.C. § 103(a) in view of US Patent 5,740,549 (hereinafter Reilly et al.). Claims 8 and 9 were rejected under 35 U.S.C. § 103(a) in view of Reilly et al. and further in view of US Patent 5,893,091 (hereinafter Hunt et al.).

The Applicants have cancelled claims 1-20 and submit new claims 21-40. Reconsideration of the instant application by the Examiner in view of the remarks below is respectfully requested.

#### **Aspects of the Claimed Invention**

By way of background, the present invention may be implemented within a framework through which Web content designers can present standard Internet content (e.g., Web pages written in HTML, XML, JavaScript) without the confines of a Web browser window frame. Within this framework, a client-side parser program that will parse, interpret and display Internet content is provided. In one embodiment, the client-side parser program, in response to user inputs, receives Internet content programmed in Web mark up language or scripting language (e.g., HTML, XML, JavaScript) from a server or server-side program. The received Internet content may contain an address, such as an URL address, and the client-side parser program may attempt to retrieve additional Internet content from the aforementioned address, and display the retrieved additional content.

Notably, the server may send Internet content that contains two or more addresses to the client-side program, causing the client-side program to retrieve Internet content from multiple locations. Such locations may be distinct URL addresses and other addresses. The server may keep track of which addresses have been sent to the client-side program, and the client-side program reports the user actions (such as exiting the program) to the server. In this way, the server may keep track of many user statistics, including which URL addresses have been viewed by a user contemporaneously.

It is respectfully submitted no other known systems are capable of keeping track of which URL addresses have been viewed by a user contemporaneously. Further, no other known systems are capable of keeping track of which URL addresses have been viewed by multiple users contemporaneously.

In one embodiment of the present invention, a system receives information associated with addressed content that was displayed on a computing device and records the information. The recorded information includes starting times and ending times for time periods during which addressed content was displayed on the computing device. Then, based on the recorded information, the system derives subsets of the addressed content that was displayed on the computing device during overlapping time periods. Notably, the prior art of record does not teach *deriving* which addressed content was displayed *simultaneously* on a computing device from *collected usage* information.

In another embodiment of the present invention, a system records information associated with a time period during which addressed content was displayed on the computing device and information associated with user activity on the computing device during that time period. The system then correlates the addressed content that was displayed on the computing device with user activity on the computing device during that time period. Notably, the prior art of record does not teach correlating addressed content that was displayed on a computing device during a time period with user activity during that time period.

Reilly et al.

Reilly et al. teach a system that makes use of viewing preferences to determine which sprites or actors (hereinafter sprites) to display on a workstation. Notably, Reilly et al. do not attempt to derive from collected usage information which sprites were displayed simultaneously. Rather, Reilly et al. teach controlling which sprites to display *prior to* displaying the sprites by means of a Subscriber Profile, where a subscriber can indicate what he wants to view and what he wants to exclude (see Reilly, FIG. 5). As Reilly et al. indicate at col. 3, lines 15-24: "At least some of the workstations include a profiler for storing subscriber profile data. The subscriber

profile data represents subscriber information viewing preferences, indicating information categories for which a subscriber associated with the workstation does and does not want to view information items. The information display controller includes a filter for excluding from the information items displayed on the display device those information items inconsistent with the subscriber profile data.” Since Reilly et al. determine which sprites to display beforehand, there is no apparent reason or motivation to later derive which sprites were displayed simultaneously from usage information.

Furthermore, Reilly et al. do not attempt to correlate sprites that are displayed during a time period with user activity during that time period. The sprites are displayed when there is no user activity at a workstation for a predetermined period of time. As Reilly et al. indicate at col. 2, lines 28-34: “It is a goal of the present invention to disseminate information and advertisements to subscribers’ computers in a system where the information and advertisements are automatically displayed when the subscriber’s computer is on but meets predefined idleness criteria. For example, the predefined idleness criteria could be the failure to receive any input for a period of at least five minutes.” Reilly et al. provide no indication that tracking user activity in relation to sprites that are displayed on the workstation during an idle period is relevant or desirable.

#### Hunt et al.

Hunt et al. teach a system for sending alerts to endusers. The Office Action has not indicated that Hunt et al. teach any of the elements of the independent claims. Since analysis of Hunt et al. is unnecessary for the purposes of determining the patentability of the independent claims, a detailed analysis of Hunt et al. has been omitted.

#### Claims 21-29 and 34-37

Claim 21 recites:

receiving information associated with addressed content displayed on a computing device;

recording information that includes starting times and ending times for time periods during which addressed content was displayed on said computing device; and

deriving, using said recorded information, subsets of said addressed content that was displayed on said computing device during overlapping time periods.

As indicated above, Reilly et al. do not teach “receiving information associated with addressed content displayed on a computing device.” Rather, Reilly et al. determine from user preferences what to display at a workstation before the information is actually displayed. Then information is displayed in accordance with the determination. Accordingly, the prior art of record fails to teach receiving information associated with addressed content that **was** displayed on the workstation. Accordingly, the applicants respectfully submit that Claim 21 is allowable for at least this reason.

Moreover, Reilly et al. do not teach “recording information that includes starting times and ending times for time periods during which addressed content was displayed on said computing device.” Since Reilly et al. make the determination of what to display prior to the display of the information, Reilly et al. would not be motivated to record information associated with what information was displayed on the workstation. Accordingly, the applicants respectfully submit that Claim 21 is allowable for at least this reason.

Furthermore, Reilly et al. do not teach “deriving, using said recorded information, subsets of said addressed content that was displayed on said computing device during overlapping time periods.” A first reason that the prior art would not so teach is that Reilly et al. does not and would not be motivated to record the information that is used to determine subsets of information that was displayed simultaneously. A second reason the prior art would not so teach is that information is not divided into subsets based upon whether the information was displayed simultaneously. Rather, Reilly et al. determine whether to display information based on whether

it meets certain criteria prior to the information being displayed. Accordingly, the applicants respectfully submit that Claim 21 is allowable for at least these reasons.

Establishing a prima facie case of obviousness requires that the prior art give reason or motivation to make the claimed invention. In re Dillon, 919 F. 2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (en banc), cert denied, 500 U.S. 904 (1991). Second, there must be a reasonable expectation of success. Third, the references when combined must teach or suggest all the claim limitations. MPEP 2141. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (1991).

Finally, it is impermissible to first ascertain factually what the inventor did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct the invention from such prior art. Panduit Corp. v. Dennison Manufacturing Co., 774 F. 2d 1082, 1092, 227 USPQ 337, 343 (Fed. Cir. 1985).

Applying these principles to the invention as embodied in the present claims and to the Reilly et al. reference, the Applicants respectfully submit that a proper reading of the references fails to disclose or suggest the invention embodied in Claim 21.

Claims 22-29, which depend from Claim 21, are allowable for at least the same reasons as Claim 21. Claim 34 is allowable for reasons similar to those provided with reference to Claim 21. Claims 35-37, which depend from Claim 34, are allowable for at least the same reasons as Claim 34.

#### Claims 30-33 and 38-40

Claim 30 recites:

recording information received from a computing device, the information comprising:  
information associated with a time period during which addressed content was displayed on said computing device, and

information associated with user activity on said computing device during said time period; and

correlating, using the recorded information, the addressed content that was displayed on said computing device during said time period with the user activity on said computing device during said time period.

As indicated above, Reilly et al. do not teach recording “information associated with a time period during which addressed content was displayed on said computing device.” Rather, Reilly et al. determine from user preferences what to display at a workstation before the information is actually displayed. Then information is displayed in accordance with the determination. Accordingly, the prior art of record fails to teach recording information associated with a time period during which information was displayed on the workstation. Accordingly, the applicants respectfully submit that Claim 30 is allowable for at least this reason.

Moreover, Reilly et al. do not teach recording “information associated with user activity on said computing device during said time period.” In fact, Reilly et al. indicate that the information is only displayed during an idle period during which there is *no* user activity. This specifically teaches away from recording information associated with user activity on the workstation while information is being displayed in accordance with the teachings of Reilly et al. Accordingly, the applicants respectfully submit that Claim 30 is allowable for at least this reason.

Furthermore, Reilly et al. do not teach “correlating, using the recorded information, the addressed content that was displayed on said computing device during said time period with the user activity on said computing device during said time period.” For the reasons just provided, Reilly et al. do not and would not be motivated to correlate information that was displayed on a workstation with user activity on the workstation. Reilly et al. determine whether to display information based on whether it meets certain criteria prior to the information being displayed. One of the criteria is that the workstation is idle for a predetermined period of time during which there is no user activity. Accordingly, the applicants respectfully submit that Claim 30 is allowable for at least this reason.

Claims 31-33, which depend from Claim 30, are allowable for at least the same reasons as Claim 30. Claim 38 is allowable for reasons similar to those provided with reference to Claim 30. Claims 39-40, which depend from Claim 38, are allowable for at least the same reasons as Claim 38.


Conclusion

In view of the foregoing, the Applicants respectfully submit that the references do not teach or suggest the specific systems and methods as claimed. Accordingly, the Applicants respectfully submit that the pending claims are allowable.

The Examiner is invited to call the undersigned should the Examiner believes a telephone call would expedite the disposition of this case.

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Respectfully submitted,

  
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Enclosure